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EXAMINER

COSIMANO, EDWARD R

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| ART UNIT | PAPER NUMBER |
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3629

DATE MAILED: 06/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,371

Applicant(s)

DIAZ ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 19-28, 30-40, 43-48 and 50-86 is/are pending in the application.
- 4a) Of the above claim(s) None is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19-28, 30-40, 43-48 and 50-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.

2. The following has been noted by the examiner:

A) since U.S. Patent has not been assigned, the assent by the assignee/inventors has been received in the form of a reissue declaration as required by 37 CFR § 1.172(a).

B) the offer to surrender the original patent has been received pursuant to 37 CFR § 1.178(a).

C) the reissue seeks to broaden the claims.

D) the reissue application has been filed within 2 (TWO) years.

E) the reissue declaration fails to set forth at least one error as required by 37 CFR § 1.175(b)(1) that is corrected by the reissue.

F) the reissue declaration filed March 29, 2001 complies with 37 CFR § 1.175(a)(2).

3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(g)-1.121(h).

4. Claims 6, 8 & 86 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4.1 Applicant's use of the amended phrase "is configured to calculate a total fat intake target is derived using said predetermined user personal data" in claim 6 is confusing and unclear since applicant's placement of the phrase "to calculate" followed by the phrase "is derived" does not make sense.

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4.2 Applicant's repeated references to "claim 1" through out the body portion (that which appears after the word "comprises;") of claim 8 is confusing and unclear, since this reference causes a confusion in regard to the dependency of this claim.

4.3 In claim 86, applicant appears confusingly repeats lines 12-14, "said display portion ... through an exercise menu," of this claim at lines 14-16, "said display portion ... through an exercise menu," of this claim. Should each of the references to "exercise" at lines 15 & 16 be --nutrition--.

4.4 For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

5. Claims 16, 19-28, 30-40, 43-48 & 50-86 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

5.1 In the amendment filed May 22, 1998 and July 03, 1998 during the prosecution of U.S. Paten no. 5,890,128, applicant to remove a rejection under 35 U.S.C. § 102(a,b) based on prior art amending independent claims 1 & 15 to include an additional recitation of "nutrition/exercise menus" and further argued that the applied prior art does not teach this feature. Although claims 16, 19-28, 30-40, 43-48 & 50-86 recite the selection of either nutrition data or exercise data via menus, these claims do not limit this selection to using both nutrition and exercise menus as required by the above amendments to original claims 1 & 15. Hence, applicant is attempting to recapture subject matter lost during the prosecution of U.S. Paten no. 5,890,128.

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6. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR § 1.175(a)(1) and MPEP § 1414.

A) in regard to claims 1-14, and in particular claims 1-6, in the amendment filed May 06, 2002 applicant makes various amendments to these claims but fails to identify the either error which is being corrected by these amendment or how these amendments overcome an error. (37 CFR § 1.175(b)(1)).

B) in regard to cancelled claims 17, 18, 29, 41, 42 & 49, the reissue declaration indicates that claims 16-85 correct an error, however it can not be seen how cancelled claims can correct an error.

C) in regard to new claims 36, 40, 43-48 & 50-86, and in particular new independent claims 36, 40, 55 & 86, in the amendment filed May 06, 2002 applicant submits these new claims but fails to identify either the error which is being corrected by each of these new claim groups, i.e. (1) claim 36 and dependent claims 56-74; (2) claim 40 and dependent claims 43-48 & 50-54; (3) claim 55 and dependent claims 75-85; and (4) claim 86, or how these new claims overcome an error. (37 CFR § 1.175(b)(1)).

6.1 In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR § 1.175(b)(1) must be received before this reissue application can be allowed.

6.2 Claims 1-16, 19-28, 30-40, 43-48 & 50-86 are rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251. See 37 CFR § 1.175. The nature of the defect is set forth above.

6.3 Receipt of an appropriate supplemental oath/declaration under 37 CFR § 1.175(b)(1) will overcome this rejection under 35 U.S.C. § 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

“Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant.”

6.3.1 Note the above rejection of in claims 6 and 8 under 35 U.S.C. § 112 2nd paragraph.

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7. The following is an Examiner's Statement of Reasons for indicating Allowability over the prior art:

A) the prior art for example either:

(1) Barron (3,984,666) which discloses determining the calories burned during exercise; or

(2) Brouns et al (EPO 0537113 A1) which disclose the need to replace nutritional supplements expended during exercise; or

(3) Sugarman et al (5,796,640) which disclose a dietary aid to aid the user in determining the nutritional value of various items; or

(4) Goldberg which disclose a connection between the nutritional intake of a person over a period of time and the suggesting exercise.

B) however, in regard to claims 1 & 15, the prior art does not teach or suggest the use of both nutrition and exercise menus to select nutritional intake values and calories burned during exercise. Claims 2-14 are allowable for the same reason.

C) however, in regard to claims 2, 15, 16, 40 & 55 the prior art does not teach or suggest the use of a wireless communications link to enter exercise data. Claims 19-28, 30-35, 37-39, 43-48, 50-54 & 75-85 are allowable for the same reason.

D) however, in regard to claims 13, 15, 36 & 55 are the prior art does not teach or suggest the use of a password to access and/or create the user data. Claims 56-85 are allowable for the same reason.

E) however, in regard to claim 86, the prior art does not teach or suggest suggesting a weight based on user entered values for sex, frame, lifestyle, height and age.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

8.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

8.2 The fax phone number for OFFICIAL FAXES is (703) 305-7687.

8.3 The fax phone number for AFTER FINAL FAXES is (703) 308-3691.

06/06/02



Edward R. Cosimano
Primary Examiner A.U. 3629